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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,217	03/25/2005	Takao Aichi	00862.023326	2027

5514 7590 05/25/2007  
FITZPATRICK CELLA HARPER & SCINTO  
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EXAMINER
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WHIPKEY, JASON T

ART UNIT	PAPER NUMBER
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2622

MAIL DATE	DELIVERY MODE
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05/25/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/529,217	AICHI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jason T. Whipkey	2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 34-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 34-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 7, 2007, has been entered.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 34-36, 39-41, 43-46, and 48-51 are rejected under 35 U.S.C. 102(e) as being anticipated by Ashizaki (U.S. Patent No. 7,024,500).

Regarding **claims 34, 39, 43, and 48**, Ashizaki discloses an image supply device (desktop PC 3; see Figure 2) comprising:

an interface (system bus 46) configured to connect with a storage medium (cache memory 43 and the memory in video controller 50) for storing image data (see column 11, lines 24-34) and a file (in a page description language format) describing a printing method of the image data (see column 11, lines 45-52);

a confirmation unit (CPU 42) configured to confirm whether it is possible or not to communicate with a printing apparatus (printer 5) using a predetermined protocol (the page description language<sup>1</sup>) upon starting communication with the printing apparatus (see column 17, lines 21-25); and

a transmission unit (interface unit 49) configured to transmit both a print designation (a designation of image data to be printed; see column 18, lines 11-18) created after said confirmation unit confirms that it is possible to communicate with the printing apparatus using the predetermined protocol, and the file to the printing apparatus (the PDL file is transmitted; see column 18, lines 18-21).

Regarding **claims 35, 40, 44, and 49**, Ashizaki discloses:

the print designation describes information for specifying the file (the PDL file is associated with specific image data; see column 18, lines 11-21).

Regarding **claims 36 and 41**, Ashizaki discloses:

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<sup>1</sup> Some page description languages, such as Hewlett Packard's Printer Control Language (PCL), have been described as protocols. For example, see column 8, lines 35-49, of U.S. Patent No. 6,031,623 to Smith.

a conversion unit configured to convert the contents of the file into a print designation set by the predetermined protocol, in a case that the printing apparatus cannot interpret the file (see column 17, lines 21-33).

Regarding **claims 45 and 50**, Ashizaki discloses:

a transmission unit (data input unit 31) configured to transmit a transfer request (the “implemented” command) for the file to the image supply device, based on information for specifying the file in the print designation (the command causes the transmission to proceed; see column 17, lines 6-57).

Regarding **claims 46 and 51**, Ashizaki discloses:

a request unit (CPU 35) configured to interpret the contents of the file and request image data for the image supply device using the predetermined protocol (see column 17, lines 6-57).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2622

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 37, 38, 42, 47, and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ashizaki in view of Parulski (U.S. Patent Application Publication No. 2001/0013894).

**Claim 37** can be treated like claim 34. While Ashizaki discloses that the images can be in a digital camera format (see column 16, lines 3-5), he is silent with regard to the file being in DPOF format.

Parulski discloses a digital camera that connects to a printer and transmits a print request file, wherein:

the file is recorded in the storage medium based on the standard of DPOF  
(see paragraph 34).

As suggested in paragraph 34, an advantage of storing data in a DPOF file is that print requests can be generated even when a printer is not connected. The requests can later be transmitted in a well-known format. For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have Ashizaki's system record the file in DPOF format.

Regarding **claim 38**, Parulski discloses:

an input unit (buttons that are not shown) configured to input print conditions (see paragraph 34); and

a creation unit (processor 18) configured to create the file in the storage medium based on the input by said input unit before the start of the communication with the printing apparatus (see *id.*).

**Claims 42, 47, and 52** can be treated like a combination of claims 37 and 38.

7. Claims 53 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parulski in view of Ashizaki.

Regarding **claim 53**, Parulski discloses a digital camera (10) comprising:

a photographing unit (image sensor 12) configured to acquire image data by photographing;

a setting unit (buttons that are not shown) configured to set a printing method of image data stored in a storage medium (removable flash memory storage card 330; see paragraph 34);

an interface configured to connect with the storage medium for storing the image data acquired by said photographing unit and a file (in DPOF format) describing the printing method set by said setting unit (see paragraph 34); and

a serial bus interface (USB) configured to communicate with a printer (30; see paragraph 44).

Parulski is silent with regard to communicating with the printer using a predetermined protocol.

Ashizaki discloses an imaging system (see Figure 2), wherein:

An image supply device (desktop PC 3) communicates using a predetermined protocol (a page description language; see footnote 1 *supra*);  
a confirmation unit (CPU 42) configured to confirm whether it is possible or not to communicate with a printer (5) using the predetermined protocol via said serial bus interface (1A); and  
a transmission unit (interface unit 49) configured to transmit both a print designation (a designation of image data to be printed; see column 18, lines 11-18) created after said confirmation unit confirms that it is possible to communicate with the printer using the predetermined protocol, and the file to the printer (the PDL file is transmitted; see column 18, lines 18-21).

Regarding **claim 54**, Ashizaki discloses:

the print designation describes information for specifying the file (the PDL file is associated with specific image data; see column 18, lines 11-21).

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.



Art Unit: 2622

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Whipkey, whose telephone number is (571) 272-7321. The examiner can normally be reached Monday through Friday from 9:00 A.M. to 5:30 P.M. eastern daylight time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivek Srivastava, can be reached at (571) 272-7304. The fax phone number for the organization where this application is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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May 22, 2007



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